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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/966,706

09/27/2001

Rick Rowe

IGT1P130X2/P000676-003

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04/19/2010

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3684

NOTIFICATION DATE

DELIVERY MODE

04/19/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@wavsip.com

Office Action Summary	Application No. 09/966,706	Applicant(s) ROWE ET AL.	
	Examiner Susanna M. Diaz	Art Unit 3684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-36 is/are pending in the application.
- 4a) Of the above claim(s) 28-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/16/09;3/17/10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This final Office action is responsive to Applicant's amendment filed March 17, 2010.

Claim 36 has been amended.

Claims 28-35 remain withdrawn as being directed toward non-elected claims.

The restriction requirement has been made final.

Claim 36 stands rejected.

Response to Arguments

2. Applicant's arguments filed March 17, 2010 have been fully considered but they are not persuasive.

Applicant continues to traverse the restriction requirement (page 5 of Applicant's response). The requirement for election was previously made final. Applicant has the option of petitioning the finality of the restriction/election requirement.

Applicant submits that the claim amendment ties the method to a computer system comprising a plurality of gaming devices and a financial transaction host, thus overcoming the rejection under § 101 (page 6 of Applicant's response). The machine is not involved in any significant processing steps (such as a determination step); therefore, the claim continues to be non-statutory.

Applicant argues that Nhaissi is non-analogous art since it relates to internet billing (page 7 of Applicant's response). In response to Applicant's argument that Nhaissi is nonanalogous art, it has been held that a prior art reference must either be in

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the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Applicant's invention is directed toward a gambling environment in which tax liabilities for winnings are tracked. Similarly, Nhaissi tracks gambling winnings and related tax liabilities (¶¶ 179-180).

Applicant argues, "The Examiner appears to have used the claim as a road-map and chose Nhaissi to plug the gap left in the three way combination of Crevelt, Johnson, and Walker." (Page 9 of Applicant's response) In response to Applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The Examiner has established a *prima facie* case of obviousness without relying solely on knowledge gleaned from Applicant's disclosure.

Applicant's arguments are not persuasive and the art rejection is maintained.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 36 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines. '); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').⁷ A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Also noted in *Bilski* is the statement, "Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-

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transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere ‘insignificant post-solution activity.’”

(*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)) Examples of insignificant post-solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test. Please refer to the USPTO’s “Guidance for Examining Process Claims in view of *In re Bilski*” memorandum dated January 7, 2009,

http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski_guidance_memo.pdf .

It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495), <http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf> .

Claim 36 is not tied to a particular machine or apparatus nor does it transform a particular article into a different state or thing, thereby failing the machine-or-transformation test. Creating a data file and storing information used to play games at a gaming machine are both insignificant extra-solution activity; therefore, claim 36 is non-statutory under § 101.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crevelt et al. (U.S. Patent No. 5,902,983) in view of Johnson (US 2001/0031663 A1) in view of Walker et al. (U.S. Patent No. 6,012,983) and further in view of Nhaissi et al. (US 2005/0203835 A1)

Crevelt discloses a method of monitoring player financial activities in a gaming environment in which a player may play one or more games comprising the steps of:
[Claim 36] generating a financial account corresponding to a player, said account represented by at least one data file, said at least one data file adapted to contain financial information (col. 5, lines 36-40 -- Each gaming machine may provide player tracking information and accounting information to the local area network; col. 5, lines 45-52; col. 6, lines 3-9; col. 8, lines 18-61; col. 9, lines 58-65; col. 10, line 55 through col. 11, line 9);

storing financial information regarding monetary amounts belonging to a player which may be used to play said one or more games at an electronic casino gaming machine (col. 5, lines 36-40 -- Each gaming machine may provide player tracking

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information and accounting information to the local area network; col. 5, lines 45-52; col. 6, lines 3-9; col. 8, lines 18-61; col. 9, lines 58-65; col. 10, line 55 through col. 11, line 9);

automatically creating a data file for the player at a financial transaction host if there is no data file associated with the player, wherein the data file is matched with the player using a unique identifier associated with a remote financial institution (col. 8, lines 42-67; col. 9, lines 1-29 – The player's financial account information is electronically accessed. When the player set up his/her account, a processing device must have automatically, i.e., through use of a machine/computer/processor, created a data file for the player since the player previously did not have his/her own data file for that account; Figs. 1, 2; col. 5, lines 17-45; col. 8, lines 42-61 -- Each gaming machine may provide player tracking information and accounting information to an EFT system through a local area network. The EFT system, i.e., the financial transaction host, maintains player-related data; columns 9-10 – The casino may communicate with an external financial institution to conduct transactions with an account associated with the player. Such an external account identifier would be a unique identifier associated with an outside institution. Funds may be transferred between the player's internal casino account and outside financial institution account);

storing financial information regarding monetary amounts expended by a player in playing said one or more games (col. 5, lines 36-40 -- Each gaming machine may provide player tracking information and accounting information to the local area

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network; col. 5, lines 45-52; col. 6, lines 3-9; col. 8, lines 18-61; col. 9, lines 58-65; col. 10, line 55 through col. 11, line 9); and

determining player loss from said financial information (col. 3, lines 8-18);

determining an amount won from said financial information (col. 3, lines 8-18).

Regarding claim 36, Crevelt does not expressly teach the step of preventing said player from utilizing monetary amounts associated with said account to play said one or more games for at least a period of time if said determined player loss meets certain criteria. However, Johnson discloses the step of preventing said player from utilizing monetary amounts associated with said account to play said one or more games for at least a period of time if said determined player loss meets certain criteria (¶¶ 13, 17, 19, 23). This feature of Johnson helps to curb gambling problems as well as assist casinos (and other gambling/playing locations) in conforming to jurisdictional restrictions regarding gambling loss limits (¶¶ 10, 13, 17). Crevelt too is concerned with reasonably limiting the money spent by a player on gambling/gaming machines (col. 2, lines 18-28; 31-49; col. 4, lines 54-62), as evidenced by Crevelt's statements that the prior art "likely will be unpalatable to at least some legislatures which regulate gaming" and that Crevelt addresses "a need for an EFT system that allows cashless transfers of funds to gaming machines and yet protects against rash decisions by some players to divert large amounts of their savings to gaming" (col. 2, lines 23-28). Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Crevelt to perform the step of preventing said player

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from utilizing monetary amounts associated with said account to play said one or more games for at least a period of time if said determined player loss meets certain criteria in order to help curb gambling problems as well as assist casinos (and other gambling/playing locations) in conforming to jurisdictional restrictions regarding gambling loss limits (as suggested in both ¶¶ 10, 13, and 17 of Johnson and col. 2, lines 23-28 of Crevelt).

Crevelt does not explicitly disclose the step of storing a threshold win amount limit, above which subsequent play should be limited or the step of comparing the amount won to the limit on the amount won. However, Walker allows players to set a limit on winnings such that automated play is stopped if the winnings threshold is exceeded (Fig. 8B, col. 8, lines 15-33, 50-61). According to Walker, "there is provided a method and apparatus for automated play which permits a casino to recognize substantially increased play time, and hence revenue, from a gaming device. At the same time, the invention satisfies a player's emotional desire to maximize his playing time on selected gaming devices, while accommodating the physical need to at times be away from the machines." (Col. 2, lines 29-37) Both Crevelt and Walker are directed toward gambling environments; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Crevelt to perform the step of storing a threshold win amount limit, above which subsequent play should be limited and the step of comparing the amount won to the limit on the amount won, as taught by Walker, in order to create an automated play environment "which permits a casino to recognize substantially increased play time, and

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hence revenue, from a gaming device [and at] the same time satisfy a player's emotional desire to maximize his playing time on selected gaming devices, while accommodating the physical need to at times be away from the machines" (as suggested in col. 2, lines 29-37 of Walker).

Furthermore, Crevelt does not explicitly disclose the steps of determining a tax liability for the amount won, withholding the tax liability from the amount won, and transferring the withholding to a withholding account. However, Nhaissi discloses that gambling winnings may be transferred into an account, with an amount to be paid in taxes designated as such within the account (Nhaissi: ¶ 180). Alternatively, the taxes may be transferred directly to a tax authority (Nhaissi: ¶ 179). Since gambling winnings are often subject to local and federal taxing laws, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Crevelt to perform the steps of determining a tax liability for the amount won, withholding the tax liability from the amount won, and transferring the withholding to a withholding account in order to facilitate convenient and accurate collection of gambling-related taxes owed to local and federal taxing authorities.

Regarding claim 36, the Examiner notes that there is very little integration among the recited steps. As seen in the cited references, the elements are all known even when not necessarily combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. Furthermore, when combined, the elements perform the same function as they did separately, thereby further supporting the Examiner's assertions that it would have been obvious to

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one of ordinary skill in the art at the time of Applicant's invention to combine the aforementioned references to address the claimed invention as explained above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna M. Diaz/
Primary Examiner, Art Unit 3684